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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,345	06/25/2001	Akiko Hemmi	41935	9024

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ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.
1300 19TH STREET, N.W.
SUITE 600
WASHINGTON,, DC 20036

EXAMINER

MRUK, BRIAN P

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 11/17/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

CLO8

Office Action Summary

Application No.

09/887,345

Applicant(s)

HEMMI ET AL.

Examiner

Brian P Mruk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7,9,11,13,14,16,17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,9,11,13,14,16,17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other:

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DETAILED ACTION

1. This Office action is in response to Applicant's amendment filed September 3, 2003. Applicant has amended claim 13. Claims 2, 4, 6, 8, 10, 12, 15 and 18 have been cancelled. New claims 20 and 21 have been added. Currently, claims 1, 3, 5, 7, 9, 11, 13-14, 16-17, and 19-21 remain pending in the application.
2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office action, Paper No. 7.
3. The rejection of claims 1-19 under 35 U.S.C. 102(b) as being anticipated by Hughes et al, EP 398,724, is withdrawn in view of applicant's amendments, remarks, and 1.132 Declaration.

NEW GROUNDS OF REJECTION

Response to Amendment

4. The amendment filed September 3, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Independent claim 13 recites that the polymer has a clay dispersibility in high-hardness water of not

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less than 0.47. However, the examiner notes that the examples in Table 1 of the specification are the only place where the values for the clay dispersibility are located. Furthermore, the examiner notes that the highest recited value is 0.60. Thus, applicant does not have support for a polymer that has a clay dispersibility that is higher than 0.6, which is recited in instant claim 13 with the phrase "not less than 0.47".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 13-14, 16, 19 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 13 recites that the polymer has a clay dispersibility in high-hardness water of not less than 0.47. However, the examiner notes that the examples in Table 1 of the specification are the only place where the values for the clay dispersibility are located. Furthermore, the examiner notes that the highest recited value is 0.60. Thus, applicant does not have

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support for a polymer that has a clay dispersibility that is higher than 0.6, which is recited in instant claim 13 with the phrase "not less than 0.47".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1, 3, 5, 7, 9, 11, 13-14, 16-17 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamaguchi et al, U.S. Patent No. 6,444,771.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

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the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Yamaguchi et al, U.S. Patent No. 6,444,771, discloses an acrylic acid-maleic acid copolymer that has a weight-average molecular weight of 2,000-50,000, a calcium ion scavengeability of 400 mg CaCO₃ per gram or more, and a clay dispersibility of 0.6 or more (see abstract and col. 3, lines 5-13). It is further taught by Yamaguchi et al that suitable polymerization initiators include hydrogen peroxide and ammonium persulfate (see col. 7, lines 16-30), that the addition of the hydrogen peroxide is completed at least 10 minutes earlier than the addition of the monomer component (see col. 7, lines 31-40), and that the polymers are used in detergent compositions (see col. 8, lines 54-67), per the requirements of the instant invention. Specifically, note Examples 1-1 through 1-6, and Table 1-8. Therefore, instant claims 1, 3, 5, 7, 9, 11, 13-14, 16-17 and 19-21 are anticipated by Yamaguchi et al, U.S. Patent No. 6,444,771.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 11, 13-14, 16-17, 19 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,444,771. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 13-14, 16-17, 19 and 21 of the instant invention and claims 1-15 of U.S. Patent No. 6,444,771 claim a similar polymer and detergent composition comprising an acrylic acid-maleic acid copolymer that has a weight-average molecular weight of 2,000-50,000, a calcium ion scavengeability of 400 mg CaCO_3 per gram or more, and a clay dispersibility of 0.6 or more (see claims 1-15 of U.S. Patent No. 6,444,771). Therefore, instant claims 11, 13-14, 16-17, 19 and 21 are an obvious formulation in view of claims 1-15 of U.S. Patent No. 6,444,771.

Response to Arguments

11. Applicant's arguments with respect to claims 1, 3, 5, 7, 9, 11, 13-14, 16-17, and 19-21 have been considered but are moot in view of the new ground(s) of rejection.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (703) 305-0728. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (Before Final) and (703) 872-9311 (After Final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Bpm

Brian Mruk
November 10, 2003

Brian P. Mruk

Brian P. Mruk
Patent Examiner
Tech Center 1700